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Please find below and/or attached an Office communication concerning this application or proceeding.

<u>.</u>		Applicat	ion No.	Applicant(s)				
Office Action Summary		10/764,6	847	TRAN, BAO				
		Examine	r	Art Unit				
		Rachna	Singh	2176				
The MAILING DATE of this communication appears on the cover sheet with the correspondence address								
Period for Reply A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION. - Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication. - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).								
Status								
2a)⊠	 Responsive to communication(s) filed on <u>12 April 2006</u>. This action is FINAL. 2b) This action is non-final. Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i>, 1935 C.D. 11, 453 O.G. 213. 							
Dispositi	on of Claims							
5)☐ 6)⊠ 7)☐ 8)☐ Applicati 9)☐ 10)☐	Claim(s) 1-21 is/are pending in the appear of the above claim(s) is/are allowed. Claim(s) is/are allowed. Claim(s) 1-21 is/are rejected. Claim(s) is/are objected to. Claim(s) are subject to restrict on Papers The specification is objected to by the The drawing(s) filed on is/are: Applicant may not request that any object of the oath or declaration is objected to	ion and/or election Examiner. a) accepted or b tion to the drawing(s) the correction is requi	requirement.)□ objected to by the because Sected in abeyance. Sected if the drawing(s) is objected if the drawing(s)	e 37 CFR 1.85(a). jected to. See 37 C				
Priority u	nder 35 U.S.C. § 119							
 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) All b) Some * c) None of: 1. Certified copies of the priority documents have been received. 2. Certified copies of the priority documents have been received in Application No 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). * See the attached detailed Office action for a list of the certified copies not received. 								
2) Notice 3) Inform	e of References Cited (PTO-892) e of Draftsperson's Patent Drawing Review (PT nation Disclosure Statement(s) (PTO-1449 or F No(s)/Mail Date		4) Interview Summary Paper No(s)/Mail Do 5) Notice of Informal F 6) Other:	ate	O-152)			

Art Unit: 2176

DETAILED ACTION

1. This action is responsive to communications: Remarks filed 04/12/06.

2. Claims 1-21 are pending. Claims 1, 19, 20, and 21 are independent claims.

Claim Objections

3. Claims are misnumbered. The claim listing is missing claim 11 and comprises two "Claim 15". Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. "Second Claim 15" is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claim recites "mapping intellectual property for an industry covered by the patent or patent application". It is unclear what the claim is intended to mean, as there is no description for this feature in the Applicant's specification.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
- 6. Claims 1-7, 10, 12-15, and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over <u>Gonzales</u>, US 2002/0161603 A1, 10/31/02 in view of <u>Sweet et al.</u>, US 6,567,799 B2, 05/20/03.

In reference to claims 1 and 19-21, Gonzales teaches an interactive publishing system for providing content management. Gonzales teaches a browser-based publishing tool allows a user to create a document that includes a hyperlink enabling a person viewing the document to navigate from a first point in the document to a second point in the document, or further to another document. See page 1, paragraph [0007]. Gonzales further teaches a web page (i.e. document) include areas designated to contain content e.g., text and images, or to provide navigation bars (nav) from a presently displayed page to another. These areas can comprise several regions. See figure 2. A hyperlink, or link, is a text or image area on which a user can click to connect to or reference another document or content component. A link can connect

Application/Control Number: 10/764,647

Art Unit: 2176

two web pages, i.e., an internal link, or two websites, i.e., an external link. See page 3, paragraphs [0045]-[0047] and figure 2. Compare to "embedding one or more links in the first portion referencing one or more external documents" and "embedding one or more links in the third portion referencing information contained in the second portion".

Gonzales does not expressly teach the one or more external documents are "viewable using a viewer application"; although he does teach viewing the documents via a browser. Sweet teaches retrieving documents linked to an initial document. Sweet teaches in response to a request from a user, a PDF viewer may retrieve from one or more web servers an initial document specified by a URL and other documents which are linked to the initial document. See column 8, lines 26-50. The PDF document is displayed by the PDF viewer. See column 8, lines 26-50. Compare to "documents viewable using a viewer application". It would have been obvious to a person of ordinary skill in the art at the time of the invention to provide a viewer application to view documents referenced in Gonzales' system because it was desirable to provide a means to convert a semantic markup representation of a document into a physical markup representation of the document (i.e. PDF) as it provides a common and convenient way for display data to be stored as a single document, having a fixed page size. See columns 3-4 of Sweet.

In reference to claim 2, Gonzales does not teach the document is a PDF document residing in a PDF file; however Sweet does. Sweet teaches in response to a

Application/Control Number: 10/764,647

Art Unit: 2176

request from a user, a PDF viewer may retrieve from one or more web servers an initial document specified by a URL and other documents which are linked to the initial document. See column 8, lines 26-50. The PDF document is displayed by the PDF viewer. See column 8, lines 26-50. Compare to "documents viewable using a viewer application". It would have been obvious to a person of ordinary skill in the art at the time of the invention to provide a viewer application to view documents referenced in Gonzales' system because it was desirable to provide a means to convert a semantic markup representation of a document into a physical markup representation of the document (i.e. PDF) as it provides a common and convenient way for display data to be stored as a single document, having a fixed page size. See columns 3-4 of Sweet.

In reference to claim 3, Gonzales does not teach encapsulating one or more links into a PDF file; however Sweet does. Sweet teaches the PDF document may have hypertext links to web pages, as well as internal pages within the document. The link is integrated into the PDF document and displayed by the PDF viewer. See column 8, lines 42-50. It would have been obvious to a person of ordinary skill in the art at the time of the invention to encapsulate the links into the PDF file because it allows a user to link to a page within the PDF document. See column 8, lines 42-50.

In reference to claim 4, Gonzales does not teach the viewer application is a PDF application; however, Sweet does. Sweet teaches in response to a request from a user,

Application/Control Number: 10/764,647

Art Unit: 2176

a PDF viewer may retrieve from one or more web servers an initial document specified by a URL and other documents which are linked to the initial document. See column 8,

lines 26-50. The PDF document is displayed by the PDF viewer. See column 8, lines

26-50. Compare to "documents viewable using a viewer application". It would

have been obvious to a person of ordinary skill in the art at the time of the invention to

provide a viewer application to view documents referenced in Gonzales' system

because it was desirable to provide a means to convert a semantic markup

representation of a document into a physical markup representation of the document

(i.e. PDF) as it provides a common and convenient way for display data to be stored as

a single document, having a fixed page size. See columns 3-4 of Sweet.

In reference to claim 5, Gonzales does not teach retrieving one or more pages of an external document referenced by a link and consolidating all pages into the external document; however, Sweet does. Sweet teaches a web page integrator which is a part of a PDF viewer. The PDF viewer may request the integrator to retrieve from one or more web servers, an initial document specified by a URL supplied by the user or other documents which are linked, directly or indirectly, to the initial document. When the documents are retrieved, the web page integrator integrates them into a single PDF document which is then displayed by the PDF viewer. See column 8, lines 26-41. It would have been obvious to a person of ordinary skill in the art at the time of the invention to consolidate all pages into the external document because it was desirable to provide a means to convert a semantic markup representation of a document into a

physical markup representation of the document (i.e. PDF) as it provides a common and convenient way for display data to be stored as a single document, having a fixed page size. See columns 3-4 of Sweet.

In reference to claim 6, Gonzales further teaches a web page (i.e. document) include areas designated to contain content e.g., text and images, or to provide navigation bars (nav) from a presently displayed page to another. These areas can comprise several regions. See figure 2. A hyperlink, or link, is a text or image area on which a user can click to connect to or reference another document or content component. A link can connect two web pages, i.e., an internal link, or two websites, i.e., an external link. See page 3, paragraphs [0045]-[0047] and figure 2. Neither Gonzales nor Sweet disclose the document comprises a patent or patent application where the first portion is a prior art section, the second portion is a description section, and the third section is a claim section; however, the prior art section, description and claim sections are merely paragraphs of a document. As both Gonzales and Sweet teach that the documents comprise text (See page 3, paragraph [0046] of Gonzales), it would have been obvious to a person of ordinary skill in the art at the time of the invention to draft the document such that the text depicted a description of an invention, a claim of a patent application, or listed prior art references because a description, claim, and prior art are simply text.

In reference to claim 7, Gonzales teaches a web page (i.e. document) includes areas designated to contain content e.g., text and images, or to provide navigation bars (nav) from a presently displayed page to another. These areas can comprise several regions. See figure 2. A hyperlink, or link, is a text or image area on which a user can click to connect to or reference another document or content component. A link can connect two web pages, i.e., an internal link, or two websites, i.e., an external link. See page 3, paragraphs [0045]-[0047] and figure 2. Neither Gonzales nor Sweet disclose the document comprises a claim section; however, the claim section is merely a paragraph of a document. As both Gonzales and Sweet teach that the documents comprise text (See page 3, paragraph [0046] of Gonzales), it would have been obvious to a person of ordinary skill in the art at the time of the invention to draft the document such that the text depicted a description of an invention, a claim of a patent application, or listed prior art references because a description, claim, and prior art are simply text.

In reference to claim 10, Gonzales further teaches a web page (i.e. document) include areas designated to contain content e.g., text and images, or to provide navigation bars (nav) from a presently displayed page to another. These areas can comprise several regions. See figure 2. A hyperlink, or link, is a text or image area on which a user can click to connect to or reference another document or content component. A link can connect two web pages, i.e., an internal link, or two websites, i.e., an external link. See page 3, paragraphs [0045]-[0047] and figure 2. Neither Gonzales nor Sweet disclose the document comprises a patent or patent application

where the first portion is a prior art section, the second portion is a description section, and the third section is a claim section; however, the prior art section, description and claim sections are merely paragraphs of a document. As both Gonzales and Sweet teach that the documents comprise text (See page 3, paragraph [0046] of Gonzales), it would have been obvious to a person of ordinary skill in the art at the time of the invention to draft the document such that the text depicted a the claim of a patent application and file history because a claim and file history are simply text.

In reference to claim 12, Gonzales further teaches a web page (i.e. document) include areas designated to contain content e.g., text and images, or to provide navigation bars (nav) from a presently displayed page to another. These areas can comprise several regions. See figure 2. A hyperlink, or link, is a text or image area on which a user can click to connect to or reference another document or content component. A link can connect two web pages, i.e., an internal link, or two websites, i.e., an external link. See page 3, paragraphs [0045]-[0047] and figure 2. Neither Gonzales nor Sweet disclose the document comprises a patent or patent application where the first portion is a prior art section, the second portion is a description section, and the third section is a claim section; however, the prior art section, description and claim sections are merely paragraphs of a document. As both Gonzales and Sweet teach that the documents comprise text (See page 3, paragraph [0046] of Gonzales), it would have been obvious to a person of ordinary skill in the art at the time of the invention to draft the document such that the text depicted a description of an invention,

a claim of a patent application, or listed prior art references because a description, claim, and prior art are simply text.

In reference to claims 13-14, Gonzales teaches a database contains data relating to articles and documents that are developed by the users of system over the Internet.

See pages 2, paragraph [0040] and page 3, paragraphs [0045].

In reference to first claim 15, Gonzales further teaches a web page (i.e. document) include areas designated to contain content e.g., text and images, or to provide navigation bars (nav) from a presently displayed page to another. These areas can comprise several regions. See figure 2. A hyperlink, or link, is a text or image area on which a user can click to connect to or reference another document or content component. A link can connect two web pages, i.e., an internal link, or two websites, i.e., an external link. See page 3, paragraphs [0045]-[0047] and figure 2. Neither Gonzales nor Sweet disclose the document comprises a patent or patent application where the first portion is a prior art section, the second portion is a description section, and the third section is a claim section; however, the prior art section, description and claim sections are merely paragraphs of a document. As both Gonzales and Sweet teach that the documents comprise text (See page 3, paragraph [0046] of Gonzales), it would have been obvious to a person of ordinary skill in the art at the time of the invention to draft the document such that the text depicted a description of an invention,

Art Unit: 2176

a claim of a patent application, or listed prior art references because a description, claim, and prior art are simply text.

In reference to second claim 15, Gonzales teaches the document comprises text. This text could be related to a patent application or patent. As both Gonzales and Sweet teach that the documents comprise text (See page 3, paragraph [0046] of Gonzales), it would have been obvious to a person of ordinary skill in the art at the time of the invention to draft the document such that the text depicted a description of an invention, a claim of a patent application, or listed prior art references because a description, claim, and prior art are simply text.

7. Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gonzales, US 2002/0161603 A1, 10/31/02 in view of Sweet et al., US 6,567,799 B2, 05/20/03, as applied to claim 6 above, and further in view of Fogel et al., US 2004/0059994, 03/25/04 (filed 12/02/02).

In reference to claims 8-9, Gonzales/Sweet do not teach visualizing the claims in a tree view or drilling down details of each claim in the tree view; however Fogel does. Fogel teaches a method of checking semantic and syntactical correctness of claims in a claim tree format. The dependencies tree for each claim is built with at least one independent claim. See abstract and page 8. It would have been obvious to a person of ordinary skill in the art at the time of the invention to represent patent claims in a tree

view as it depicts the relationships among independent and dependent claims. See page 5, paragraph [0229].

8. Claims 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gonzales, US 2002/0161603 A1, 10/31/02 in view of Sweet et al., US 6,567,799 B2, 05/20/03, as applied to claim 1 above, and further in view of Mahoney et al., US 5,999,664, 12/07/99.

In reference to claims 16-17, Gonzales/Sweet do not disclose using OCR from an image of the page and associating text with the corresponding location of the text in the image; however, Mahoney does. Mahoney teaches it was well known at the time of the invention to utilize OCR for search and retrieval of a document image. OCR distinguishes each bitmap of a character from its neighbor, analyzes the appearance, and distinguishes it from other characters in a predetermined set of characters. See page 3, lines5-51. Mahoney further teaches scanned images may be represented as PDF documents. See column 1, lines 34-40. It would have been obvious to a person of ordinary skill in the art at the time of the invention to enable searching a document using OCR in a PDF document as it was desirable at the time of the invention to search for a document stored in a large database particularly hardcopy documents that are scanned as images having no structural definition as it would not be perceivable by a computer, thus there was a need to analyze image data and pixels to help identify a document stored in a large corpus of documents. See columns 1-2 of Mahoney.

Art Unit: 2176

9. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gonzales, US 2002/0161603 A1, 10/31/02 in view of Sweet et al., US 6,567,799 B2, 05/20/03, as applied to claim 1 above, and further in view of Bargeron et al., US 2004/0205542 A1, 10/14/04 (filed 09/07/01).

In reference to claim 18, Gonzales/Sweet do not teach saving user annotations in the document; however, Bargeron does. Bargeron teaches the anchoring of annotations to content. On page 1, paragraph [0005], Bargeron discloses an annotation is associated with a particular portion of content. It would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate Bargeron's annotation in the document in the system of Gonzales/Sweet as it was desirable to provide a means to preserve the annotations in a digital document because digital documents are easily and frequently altered, thereby changing the portion of the document to which the annotation corresponds. It would thus be beneficial to provide a way to improve the manner in which annotations are associated with portions of documents so that the annotations are still associated with the correct portion of the document despite alterations to the underlying content. See page 1, paragraph [0004].

Response to Arguments

10. Applicant's arguments filed 04/12/06 have been fully considered but they are not persuasive.

Applicant notes on page 2 of the response, the current invention is "about a portable electronic document descriptive of a particular intellectual property having three portions and wherein the third portion whose scope is interpreted based on the second portion". It is noted that neither claim 1 nor claims 19, 20, or 21 recite "an intellectual property document". The independent claims simply recite "an electronic document".

Applicant further argues on page 4 of the response, Gonzales does not show embedding one or more links in the first portion referencing one or more external documents viewable using a viewer application. Additionally, Applicant argues Gonzales fails to show embedding one or more links in the third portion referencing information contained in the second portion. Examiner respectfully disagrees.

Gonzales teaches an interactive publishing system for providing content management. Gonzales teaches a browser-based publishing tool allows a user to create a document that includes a hyperlink enabling a person viewing the document to navigate from a first point in the document to a second point in the document, or further to another document. See page 1, paragraph [0007]. Compare to *embedding one or more links in the first portion referencing one or more external documents*.

Gonzales further teaches a web page (i.e. document) include areas designated to contain content e.g., text and images, or to provide navigation bars (nav) from a presently displayed page to another. These areas can comprise several regions. See figure 2. A hyperlink, or link, is a text or image area on which a user can click to

connect to or reference another document or content component. A link can connect two web pages, i.e., an internal link (compare to "embedding one or more links in the third portion referencing information contained in the second portion"), or two websites, i.e., an external link. See page 3, paragraphs [0045]-[0047] and figure 2.

While Gonzales does not expressly teach the one or more external documents are "viewable using a viewer application"; although he does teach viewing the documents via a browser. Sweet teaches retrieving documents linked to an initial document. Sweet teaches in response to a request from a user, a PDF viewer may retrieve from one or more web servers an initial document specified by a URL and other documents which are linked to the initial document. See column 8, lines 26-50. The PDF document is displayed by the PDF viewer. See column 8, lines 26-50. Compare to "documents viewable using a viewer application". It would have been obvious to a person of ordinary skill in the art at the time of the invention to provide a viewer application to view documents referenced in Gonzales' system because it was desirable to provide a means to convert a semantic markup representation of a document into a physical markup representation of the document (i.e. PDF) as it provides a common and convenient way for display data to be stored as a single document, having a fixed page size. See columns 3-4 of Sweet.

Examiner notes that Gonzales' teaching of a document that including a hyperlink enabling a person viewing the document to navigate from a first point in the document to a second point in the document, or further to another document on page 1, paragraph [0007] is the same as referencing an external document. Examiner further notes that an

internal link linking to a second point in a document comprising several regions is the same as linking to one portion of the document to another portion of the document. The claimed invention recites embedding one or more links in the third portion referencing information in the second portion. Gonzales teaches a document comprising several regions which is the same as a document having one portion, a second portion, and a third portion. This is further depicted in figure 2 of Gonzales where the document is divided into three regions.

With respect to claim 6, Applicant argues neither Gonzales nor Sweet teaches the electronic document comprises a patent or patent application wherein the first portion is a prior art section, the second portion is a description section, and the third portion comprises a claim section, comprising cross-referencing an element in the claim section against one or more references to the element in the specification section.

As previously noted in the rejections regarding claim 6, Gonzales teaches a web page (i.e. document) include areas designated to contain content e.g., text and images, or to provide navigation bars (nav) from a presently displayed page to another. These areas can comprise several regions. See figure 2.

Neither Gonzales nor Sweet disclose the document comprises a patent or patent application where the first portion is a prior art section, the second portion is a description section, and the third section is a claim section; however, the prior art section, description and claim sections are merely <u>paragraphs</u> of a document. As both Gonzales and Sweet teach that the documents comprise text (See page 3, paragraph

Art Unit: 2176

[0046] of Gonzales), it would have been obvious to a person of ordinary skill in the art at the time of the invention to draft the document such that the text depicted a description of an invention, a claim of a patent application, or listed prior art references because a description, claim, and prior art are simply text, sentences, and paragraphs. Gonzales and Sweet teach that documents comprise text. See page 3, paragraph [0046] of Gonzales.

On pages 4-5, Applicant argues that none of the claim features of the pending claims are taught by the reference. Applicant merely argues that the limitations are not taught without pointing out why the portions of the reference that the Examiner purports teaches the recited claim limitations does not in fact teach what the Applicant is claiming. Broad, general statements alleging that the Examiner has not taught the claim limitations without reasons why the cited portions of the reference do not teach the limitations are mere pleadings and fail to provide evidence to the contrary.

As Examiner has noted in the previous office action and in a previous interview, a electronic document comprising a claim section, description section, or prior art section is simply viewed as a document comprising text. A claim of a patent is merely a sentence. The "description" of a document is merely text in the form of paragraphs and "prior art" is also merely text. Further, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the

Art Unit: 2176

prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

On page 8 of the Arguments with respect to claims 8-9, Applicant states there is no suggestion to combine Gonzales with a portable document but provides not reason why such a combination as suggested in the previous office action is not valid. As stated previously, Gonzales/Sweet do not teach visualizing the claims in a tree view or drilling down details of each claim in the tree view; however Fogel does. Fogel teaches a method of checking semantic and syntactical correctness of claims in a claim tree format. The dependencies tree for each claim is built with at least one independent claim. See abstract and page 8. It would have been obvious to a person of ordinary skill in the art at the time of the invention to represent patent claims in a tree view as it depicts the relationships among independent and dependent claims. See page 5, paragraph [0229].

With respect to claims 16-17, Applicant merely states the office's position without providing any arguments.

It is further noted that objections and 112 rejections previously presented have not been overcome by any arguments and/or amendments.

In view of the comments above, the rejection is maintained.

Art Unit: 2176

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachna Singh whose telephone number is 571-272-4099. The examiner can normally be reached on M-F (8:30AM-6:00PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

Art Unit: 2176

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RS 06/12/06

HEATHER R. HERNDON

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JPERVISORY PATENT EXAMINER

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